

### REMARKS

Claims 1-5, 7-12, 14-19, 21-31, 33-44, 46-57, 59-62, and 64-66 are all the claims pending in the application. Dependent claims 6, 13, 20, 32, 45, 58, and 63 are canceled and incorporated into respective independent claims, above. Claims 5, 12, 19, 35, 48, 61, 65, and 66 stand objected to for informalities; and, claims 1-66 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Should claims 36-48 be found allowable, claims 62 and 66 will be objected to under 35 U.S.C. §101 for statutory type double patenting; and, claims 1-66 stand rejected on prior art grounds. Applicants respectfully traverse these rejections based on the following discussion.

#### **I. Claim Objections**

Claims 5, 12, 19, 35, 48, 61, 65, and 66 are objected to because the Office Action argues that such claims do not further limit the parent claim. Specifically, the Office Action asserts that claim 1 sets forth particular method steps, yet claim 5 has language that merely describes qualities of the coupons (location) rather than further specifying steps that are executed as performance of the method. Applicants respectfully traverse these rejections based on the following discussion.

Dependent claims 5, 19, 35, and 61 have been amended to further limit their respective independent method claims (i.e., claims 1, 15, 22, and 49, respectively). Specifically, claims 5 and 19 have been amended to specify the step of: "*checking e-*

coupons that reside at any one of the group consisting of a user's site, a third party's site, and a site of said retailer in said networked environment" (emphasis added). Furthermore, claims 35 and 61 have been amended to specify the step of: "*computing* e-coupons that reside at any one of the group consisting of a user's site, a third party's site, and a site of said retailer in said networked environment" (emphasis added).

In addition, Applicants respectfully submit that dependent claims 12 and 48 further limit *apparatus* claims (i.e., independent claims 8 and 36, respectively). Specifically, independent claim 8 provides "An apparatus for determining a combination of electronic coupons (ecoupons) for redemption by a retailer in a networked environment" and the preamble of dependent claim 12 recites "The apparatus according to claim 8". Moreover, independent claim 36 provides "An apparatus for electronic coupon (e-coupon) decision support" and the preamble of dependent claim 48 recites "The apparatus according to claim 36". Therefore, because dependent claims 12 and 48 further limit apparatus claims, it is not required that they specify steps that are executed as performance of a method.

Additionally, Applicants respectfully submit that dependent claims 65 and 66 further limit a *system* claim (i.e., independent claim 62). Specifically, independent claim 62 provides "An electronic coupon (e-coupon) decision support system" and the preambles of both dependent claims 65 and 66 recite "The system according to claim 62". Therefore, because dependent claims 65 and 66 further limit a system claim, it is not required that they specify steps that are executed as performance of a method. In

view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw these objections.

## **II. The 35 U.S.C. §112, Second Paragraph, Rejections**

Claims 1-66 stand rejected under 35 U.S.C. §112, second paragraph. Specifically, the Office Action argues that claims 1, 8, 15, 22, 36, 49, and 62 are of unclear claim scope because the phrase “coupons are mutually exclusive” does not state what qualities of the coupons are mutually exclusive. Further, the Office Action asserts that there is no antecedent basis in claim 34 for a user's profile. Applicants respectfully traverse these rejections based on the following discussion.

Claims 1, 8, 15, 22, 36, 49, and 62 have been amended by Applicants to state what qualities of the coupons are mutually exclusive. Specifically, claims 1, 8, and 15 provide the step of determining “if two or more of said e-coupons can be used in combination within the same purchase”. Moreover, claims 22, 36, 49, and 62 provide the step of “determining if said computed set of e-coupons ... can be used in combination within the same purchase”.

In regards to claim 34, the term “said user's profile” has been removed and replaced with “a profile of said user”. The “user” is set forth in independent claim 22, from which claim 34 depends upon, using the following language: “computing a set of applicable e-coupons dependent upon a set of e-coupons of a user”. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw these rejections.

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### III. The 35 U.S.C. §101 Rejections

The Office Action argues that should claims 36 and 48 be found allowable, claims 62 and 66 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. Further, the Office Action states that a statutory type (35 U.S.C. 101) double patenting rejection can be overcome by amending the conflicting claims so they are no longer coextensive in scope.

Applicants have amended the claims accordingly. Claims 36 and 48 are directed towards an apparatus, and more specifically towards an apparatus for electronic coupon (e-coupon) decision support. Conversely, claims 62 and 66 (as a result of claim 66 being dependent upon claim 62) provide "An electronic coupon (e-coupon) decision support system". Specifically, the system comprises "at least one of a hardware module and a software module ... and an optimization engine".

Thus, claims 62 and 66 are directed towards a system comprising a hardware and/or a software module and an optimization engine, which is not substantially duplicative of the apparatus defined in claims 36 and 48. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw these rejections.

### IV. The Prior Art Rejections

Claims 1-33, 35-46, 48-59, 61-63, and 65-66 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fajkowski (U.S. Patent No. 6,932,270). Claims 3, 10, 17, 34, 47, 60, and 64 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fajkowski, in view of Beach, et al. (U.S. Publication No. 2002/0107738 A1), hereinafter

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referred to as Beach. Applicants respectfully traverse these rejections based on the following discussion.

**A. Rejection based on Fajkowski**

The claimed invention provides a method of determining a combination of e-coupons for redemption by a retailer in a networked environment, wherein e-coupons complying with redeeming conditions and being non-mutually exclusive are displayed dependent upon optimization parameters. In the rejection, the Office Action argues that Fajkowski discloses displaying coupons dependent upon optimization parameters. In addition, the Office Action argues that it would have been obvious to incorporate mutual exclusivity rules into the method and apparatus of Fajkowski. However, Fajkowski does not disclose displaying eligible coupons, taking into account parameters to optimize savings. Moreover, Fajkowski fails to mention situations where two or more coupons can be used in conjunction within the same purchase. Therefore, as explained in greater detail below, Applicants respectfully submit that the prior art of record does not teach or suggest the claimed invention.

The Office Action argues that it would have been obvious to incorporate mutual exclusivity rules into the method and apparatus of Fajkowski. Such a feature is defined in independent claims 1, 8, and 15 using the following language: "determine if two or more of said e-coupons can be used in combination within the same purchase"; and in independent claims 22, 36, 49, and 62 using the following language: "determining if said computed set of e-coupons ... can be used in combination within the same purchase".

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More specifically, the Office Action asserts that "It would have been obvious for one of ordinary skill in the art at the time of the invention to have stored and analyzed other well known coupon restriction rules such as whether other coupons can be used in combination with a coupon (mutually exclusive coupons). Doing so would enable the system to process and accurately display a wide variety of coupons, including those with exclusivity rules." (Office Action, p. 5, para. 1).

Applicants respectfully disagree with such a conclusion. The Office Action does not reference any support in the prior art for its contention that it would have been obvious to incorporate mutual exclusivity rules into the method and apparatus of Fajkowski.

Fajkowski fails to mention situations where two or more coupons can be used in combination within the same purchase. Further, Fajkowski fails to teach determining whether two or more coupons are mutually exclusive or other exclusivity rules. Therefore, in Fajkowski, the coupons are not analyzed for mutual exclusivity; and non-mutually exclusive *AND* mutually exclusive coupon(s) will be displayed. Conversely, in the claimed invention, the selection of e-coupons complying with redeeming conditions are checked to determine if two or more e-coupons are mutually exclusive; and *NON*-mutually exclusive coupon(s) will be displayed.

Therefore, contrary to the position taken in the Office Action, there is no teaching in the prior art to suggest that it would not have been obvious for one of ordinary skill in the art at the time of the invention to have incorporated mutual exclusivity rules into the method and apparatus of Fajkowski.

In addition, the Office Action argues that Fajkowski discloses displaying coupons dependent upon optimization parameters. Such a feature is defined in independent claims 1, 8, and 15 using the following language: “wherein said displayed selection of e-coupons is dependent upon optimization parameters”; independent claims 22, 36, and 49 using the following language: “finding an optimal set of e-coupons dependent upon optimization parameters”; and independent claim 62 using the following language: “an optimization engine adapted to determine a subset of coupons from said computed set of e-coupons ... dependent upon optimization parameters”.

In support for its assertion, the Office Action argues that displaying eligible coupons to be redeemed at the POS provides a display of coupons dependant upon optimization parameters. Specifically, if the customer has the proper products at checkout, he optimizes his savings (Office Action, p. 6, para. 2). However, the Office Action does not reference any portions of Fajkowski to support this argument. Applicants respectfully submit that Fajkowski fails to provide support for this conclusion.

Specifically, coupons that are dependent upon parameters that optimize the user's savings are not displayed merely because eligible coupons to be redeemed at the POS are provided. Determining which coupons are eligible at the POS is only a part of the process for identifying which coupons will optimize savings. In other words, the displaying of eligible coupons in Fajkowski is analogous to the claim element of “displaying said selection of e-coupons complying with said redeeming conditions” as provided in independent claims 1, 8, and 15; and the claim element of “displaying said

computed set of e-coupons determined to comply with said redeeming conditions” as provided in independent claims 22, 36, 49, and 62.

Therefore, Fajkowski does not teach the additional step of displaying which of the eligible coupons will optimize a user’s savings. Accordingly, the displaying of coupons in Fajkowski merely presents coupons that are dependent upon eligibility for particular purchase(s); Fajkowski does not take into account parameters to optimize savings.

The only “optimization parameter” that Fajkowski arguably discloses is whether coupon(s) are eligible for particular product(s) at the POS; i.e., “if the customer has the proper products at checkout, he optimizes his savings” (Office Action, p. 6, para. 2). As described above, however, this is a parameter that must be determined before any additional optimization parameters can be considered.

Fajkowski does not disclose any additional parameters to optimize savings. For example, if only a limited number of coupons may be utilized to purchase a particular product, Fajkowski does not take into account parameters such as: which coupon will provide the biggest discount, which coupon will provide the largest number of free items, and which coupon has the earliest expiration date.

Therefore, contrary to the position taken in the Office Action, Applicants submit that Fajkowski does not teach or suggest displaying non-mutually exclusive e-coupons dependent upon optimization parameters. Thus, it is Applicants' position that Fajkowski does not disclose or suggest the claimed features of “determin[ing] if two or more of said e-coupons can be used in combination within the same purchase” as defined in independent claims 1, 8, and 15; and “determining if said computed set of e-coupons ...



can be used in combination within the same purchase” as defined in independent claims 22, 36, 49, and 62. In addition, Applicants submit that Fajkowski does not disclose or suggest the claimed features of displaying “wherein said displayed selection of e-coupons is dependent upon optimization parameters” as defined in independent claims 1, 8, and 15; “finding an optimal set of e-coupons dependent upon optimization parameters” as defined in independent claims 22, 36, and 49; and “an optimization engine adapted to determine a subset of coupons from said computed set of e-coupons ... dependent upon optimization parameters” as defined in independent claim 62.

Therefore, it is Applicants’ position that Fajkowski does not teach or suggest many features defined by independent claims 1, 8, 15, 22, 36, 49, and 62 and that such claims are patentable over the prior art of record. Further, it is Applicants’ position that dependent claims 2-5, 7, 9-12, 14, 16-19, 21, 23-31, 33-35, 37-44, 46-48, 50-57, 59-61, and 64-66 are similarly patentable, not only because of their dependency from a patentable independent claims, but also because of the additional features of the invention they defined. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw this rejection.

**B. Rejection based on Fajkowski and Beach**

The Office Action argues that Beach et al also teaches user collection of e-coupons which are redeemed at the POS, wherein the coupons can be recommended to the user based on his user profile. Thus, the Office Action asserts that it would have been obvious for one of ordinary skill in the art at the time of the invention to have suggested

coupons for the user based on his profile so that the user can be conveniently targeted with offers that are likely to be accepted and purchased. These recommendations are taken to be optimal or near optimal recommendations.

Once more, however, Beach fails to teach or suggest displaying *non-mutually exclusive* e-coupons dependent upon *optimization parameters*. The Office Action does not reference any portions of Beach that are directed to such features. It is Applicants' position that Beach does not mention determining mutual exclusivity, nor does Beach mention displaying e-coupons based on optimization parameters.

Thus, Applicants submit that the proposed combination of Fajkowski and Beach does not disclose or suggest the claimed features of "determin[ing] if two or more of said e-coupons can be used in combination within the same purchase" as defined in independent claims 1, 8, and 15; and "determining if said computed set of e-coupons ... can be used in combination within the same purchase" as defined in independent claims 22, 36, 49, and 62. In addition, Applicants submit that the proposed combination of Fajkowski and Beach does not disclose or suggest the claimed features of displaying "wherein said displayed selection of e-coupons is dependent upon optimization parameters" as defined in independent claims 1, 8, and 15; "finding an optimal set of e-coupons dependent upon optimization parameters" as defined in independent claims 22, 36, and 49; and "an optimization engine adapted to determine a subset of coupons from said computed set of e-coupons ... dependent upon optimization parameters" as defined in independent claim 62.

Therefore, it is Applicants' position that the proposed combination of Fajkowski and Beach does not teach or suggest many features defined by independent claims 1, 8, 15, 22, 36, 49, and 62 and that such claims are patentable over the prior art of record. Further, it is Applicants' position that dependent claims 2-5, 7, 9-12, 14, 16-19, 21, 23-31, 33-35, 37-44, 46-48, 50-57, 59-61, and 64-66 are similarly patentable, not only because of their dependency from a patentable independent claims, but also because of the additional features of the invention they defined. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw this rejection.

**V. Formal Matters and Conclusion**

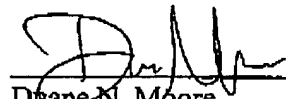
In view of the foregoing, Applicants submit that claims 1-5, 7-12, 14-19, 21-31, 33-44, 46-57, 59-62, and 64-66, all the claims presently pending in the application, are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary. Please charge any

deficiencies and credit any overpayments to Attorney's Deposit Account Number 09-0441.

Respectfully submitted,

Dated: 3/17/06

  
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